

**REMARKS/ARGUMENTS**

In light of the remarks to follow, reconsideration and allowance of this application are requested.

Claims 1-2, 5-9, and 12-14 have been rejected under 35 U.S.C. §102(e) as being anticipated by Apte et al. U.S. Patent No. 6,269,373 (Apte et al.) and the claims 3-4 and 10-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Apte et al. and further in view of U.S. Published Application No. 2002/0147696 (Acker et al.). Claims 4 and 11 have been canceled, thereby obviating the rejection of these claims. Applicants respectfully traverse these rejections with respect to the remaining claims.

Applicants submit that Apte et al. and Acker et al. are not prior art under 35 U.S.C. § 102 and the § 102 and §103 rejections in Paper Nos. 5 and 8 based on Apte et al. and Acker et al. are improper and should be withdrawn. As stated in the Declaration filed on April 19, 2004, applicants respectfully submit that well prior to the February 26, 1999 filing date of the Apte et al. patent (and well prior to the August 12, 1999 filing date of the Acker et al. published application), the present invention was conceived and reduced to practice. Both the Apte et al. patent and Acker et al. published application are therefore inapplicable as § 102 prior art and a reference that does not qualify as prior art under § 102 cannot be basis of a rejection under § 102 and §103. Applicant therefore respectfully request that rejections based on allegedly anticipation by Apte et al. and/or obviousness over the combination of Apte et al. patent and Acker et al. published application be reconsidered and withdrawn.

The Examiner alleges that the evidence submitted with the Declaration is insufficient to establish a conception of the invention of Apte et al. Applicant respectfully directs the Examiner attention to Exhibit B which includes a sample source code for SmartHandle.java, including the java.util.Comparable interface and delegation to a SmartKey for comparing attributes associated with the primary key to permit two EJB Handles to be compared without instantiating the corresponding Entity EJB Objects. Accordingly, Applicants respectfully submits that the evidence submitted with

Declaration filed on April 19, 2004 is sufficient to establish a conception of the invention prior to the effective date of Apte et al.

Moreover, contrary to the Examiner's assertion, Apte et al. independently or in combination with Acker et al. does not teach or suggest the present invention recited in claims 1 and 8. Apte et al. relates to a method for persisting a container-managed server object or bean in a distributed data processing system. Acker et al. relates to a system and method for improving name service behavior in a object-oriented programming environment, i.e., name service scoping behavior. Only the present invention teaches or suggests a SmartHandle which extends the capabilities of the EJB Handle, such as enabling part comparison of two EJB Handles without instantiating the actual EJB object, thereby advantageously enabling the present invention to order a list of SmartHandles without accessing the remote objects that they refer to (i.e., actual EJB objects), as required in amended independent claims 1 and 8.

Contrary to the Examiner's assertion, Acker et al. does not teach or suggest "delegating to a SmartKey class that implements a java code to perform a field-by-field comparison of attributes associated with said primary key, thereby permitting two EJB Handles to be compared without instantiating the corresponding Entity EJB," as required in amended claims 1 and 8 (originally recited in canceled claims 4 and 11). In fact, paragraph 38 in Acker et al. cited by the Examiner, merely states that "the scoped CBCtxFactory 704 is the intermediate layer that provides the scoping behavior ... A delegation model could be just as easily be used, or the scoped initial context factory could completely implement the javax.naming.spi.InitialContextFactory interface." Applicants respectfully submit that one of ordinary skill in the art would not equate performing a field-by-field comparison of attributes associated with said primary key, thereby permitting two EJB Handles to be compared without instantiating the corresponding Entity EJB to Acker et al.'s scoped CBCtxFactory 704 or a delegation model to implement the javax.naming.spi.InitialContextFactory interface." That is, the Examiner alleges that Acker's name service scoping behavior is equivalent to performing a field-by-field comparison of attributes associated with said primary key, thereby

permitting two EJB Handles to be compared without instantiating the corresponding Entity EJB, as called for in amended claims 1 and 8.

Applicants respectfully request that the Examiner indicate where in Ackers et al. it teaches “delegating to a SmartKey class that implements a java code to perform a field-by-field comparison of attributes associated with said primary key, thereby permitting two EJB Handles to be compared without instantiating the corresponding Entity EJB,” as required in amended claims 1 and 8 (originally recited in canceled claims 4 and 11).

Additionally, the Examiner incorrectly alleges that Apte et al. teaches the step of “maintaining an instance of a SmartKey that describes said primary key for a database column to which an Entity EJB object is mapped,” as required in claim 1 and similarly in claim 8. In fact, col. 16, lines 57-65 and col. 17, lines 21-28 in Apte et al., cited by the Examiner, merely recite that “ a container implemented on top of an RDBMS may manage persistence by storing each bean’s data as a row in a table.” Whereas the present invention teaches that the instance of a SmartKey that describes the primary key to be maintained in a database column to which an Entity EJB object is mapped. This advantageously allows the SmartKeys and the SmartHandles that contain them to be easily compared and stored in ordered lists.

Further, the Examiner incorrectly alleges that Apte et al. teaches the step of “maintaining an Entity EJB object relationship thorough a combination of a proxy pattern, an EJB Handle, and a primary key of the EJB Handle,” as required in claim 1 and similarly in claim 8. In fact, col. 16, lines 40-52 in Apte et al., cited by the Examiner, merely describes that “An entity bean can be created in two ways ...” Applicants are puzzled as to how “creation of an entity bean” is equivalent to “maintaining an Entity EJB object relationship.”

Furthermore, the Examiner incorrectly alleges that the Apte et al. teaches the step of “storing EJB Home class from which an Entity EJB was generated and from which said Entity EJB can be re-instantiated,” as required in claim 1 and similarly in claim 8. In fact, col. 16, lines 53-56 in Apte et al., cited by the Examiner, merely recites that “the bean is entirely responsible for storing and retrieving its instance data.” However,

applicants respectfully submits that one of ordinary skill in the art would not equate the step storing of its instance data by the bean to the step of “storing EJB Home class from which an Entity EJB was generated and from which said EJB can be re-instantiated,” as called for in claim 1 (similarly in claim 8).

Of course, a rejection based on 35 U.S.C. §102(e) requires that the cited reference disclose each and every element covered by the claim. *Electro Medical Systems S.A. v. Cooper Life Sciences Inc.*, 32 USPQ2d 1017, 1019 (Fed. Cir. 1994); *Lewmar Marine Inc. v. Barient Inc.*, 3 USPQ2d 1766, 1767-68 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). The Federal Circuit has mandated that 35 U.S.C. §102 requires no less than “complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” *Connell v. sears, Roebuck & Co.*, 772 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *See also, Electro Medical Systems*, 32 USPQ2d at 1019; *Verdegaal Bros.*, 814 F.2d at 631.

In view of the foregoing differences, it is respectfully submitted that Apte et al. does not anticipate nor render obvious the invention as recited in claims 1 and 8, therefore, claims 1 and 8 are patentably distinct over this prior art. It is requested the rejection of claims 1 and 8 under 35 U.S.C. §102(e) be withdrawn.

Since claims 2, 5-7, 9 and 12-14 depend from claims 1 and 8, respectively, the foregoing discussion of claims 1 and 8 is equally applicable to claims 2, 5-7, 9 and 12-14 and is believed to obviate the rejection of claims 2, 5-7, 9 and 12-14.

In addition, it should be noted that claim 2 (and similarly claim 9) recites the step of “instantiating said Entity EJB object associated with said SmartHandle with a single method invocation.” Apte et al. neither teaches or suggests such instantiating step. In fact, col. 16, lines 10-17 in Apte et al., cited by the Examiner, merely describe “stateless session beans” and is not even remotely related to an Entity Bean.

Claim 5 (and similarly claim 12) defines that “said SmartKey includes said primary key of said EJB Handle, thereby providing portability to said Entity EJB object.”

Apte et al. neither teaches or suggests such SmartKey. In fact, col. 8, lines 58-67 in Apte et al., cited by the Examiner, merely describes that Remote Method Invocation depends on many features of Java-object serialization, portable, downloadable object implementations.

Claim 6 (and similarly claim 13) recites the step of “assigning each attribute of said Entity EJB object and said SmartKey to a separate column within a relational database table, thereby permitting the SmartHandle to be mapped to a multi-column relational database table.” Apte et al. neither teaches or suggests such assigning step where each attribute of the Entity EJB object and the SmartKey are assigned to a separate column. In fact, col. 16, lines 57-61 in Apte et al., cited by the Examiner, merely describes that “a container implemented on top of an RDBMS may manage persistence by storing each bean’s data as a row in a table.”

Claim 7 (and similarly claim 14) defines that SmartHandle includes at least attributes HomeClassName, KeyClassName and HomeName. Apte et al. does not teach or suggest such SmartHandle.

As stated herein, Acker et al. relates to process and system for providing name service scoping behavior. But, Acker et al. is not suggestive of performing a field-by-field comparison of attributes associated with said primary key, thereby permitting two EJB Handles to be compared without instantiating the corresponding Entity EJB, as required in amended independent claims 1 and 8. Also, Acker et al. is not suggestive of the steps of maintaining an Entity EJB object relationship, storing EJB Home class from which an Entity EJB was generated and from which it can be re-instantiated, and maintaining an instance of a SmartKey that describes the primary key for a database column which an Entity EJB object is mapped, as required in claim 1 and similarly in claim 8. These, of course, are features recited by independent claims 1 and 8 (and thus are included in dependent claims 3 and 10) and not found in Apte et al. and Acker et al. Hence, the addition of Acker et al. does not cure the aforementioned deficiencies of Apte et al.

In view of the foregoing differences, it is respectfully submitted that the combination of Apte et al. and Acker et al. does not render obvious claims 3-4 and 10-11.

The Commissioner is hereby authorized to deduct any fee or credit any overpayment to Deposit Account No. 50-0624, under Order No. **NY-THEOR 201.1 (09907976)** from which the undersigned is authorized to draw.

Respectfully submitted,

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